

REMARKS

This reply under 37 C.F.R. §1.111 accompanies the RCE and addresses the issues of the instant Action, wherein claims 1-8, 10-18 and 20-25 are listed as pending of which claims 18 and 21-25 are listed as withdrawn from consideration, and claims 1-8, 10-17 and 20 are listed as rejected.

Pursuant to the Examiner's suggestion, Applicants have amended claim 18 to recite "A" instead of "The" insofar as claim 18 is an independent claim.

Applicants note with appreciation that the Examiner notes, at page 2 of the instant Action, that Applicants' amendments to the claims filed July 13, 2010 overcame the outstanding art rejections.

On the other hand, the Examiner notes, at page 2 of the instant Action, that "new grounds of rejection are necessitated by Applicant's IDS submission under 37 CFR 1.97(c), filed May 28, 2010." However, Applicants respectfully submit that the Examiner's making the instant Action *final* is based on the incorrect premise that the newly cited art WO 03/072754 by TARASOVA qualifies as a Section 102(b) art. This issue is discussed in greater detail hereinbelow which takes into account the telephone discussion between Applicant's undersigned attorney and Examiner Kosar which took place on this date of January 26th.

- **Applicants' response to the claim rejection under 35 U.S.C. §112**

The Examiner has rejected claims 1-8, 10-17 and 20 under 35 U.S.C. §112 as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response, Applicants have amended claim 1 to recite as reproduced immediately below:

~~Z is a ligand of a biological receptor, an analog thereof, or a derivative of said ligand or of said analog~~ selected from the group consisting of somatostatin, a somatostatin analog, LHRH, an LHRH analog, and bombesin, and a bombesin analog;

Applicants respectfully submit that the above-reproduced amendment makes clear as to what “Z” encompasses, *i.e.*, “Z is selected from the group consisting of somatostatin, a somatostatin analog, LHRH, an LHRH analog, bombesin, and a bombesin analog”. As such, Applicants respectfully request reconsideration and withdrawal of this rejection.

- **Applicants’ response to the claim rejection under 35 U.S.C. §102(b)**

The Examiner has rejected claims 1, 2 and 20 under 35 U.S.C. §102(b) as allegedly being anticipated by TARASOVA (WO 03/072754). However, it should immediately be noted that TARASOVA (WO 03/072754) does NOT qualify as Section 102(b) art because its publication date is September 4, 2003, whereas the instant application is entitled to the benefit of the filing date of April 22, 2003. That is, in order to qualify as a prior art under 35 U.S.C. §102(b), the publication date of TARASOVA (WO 03/072754) must be “more than one year prior to the date of [the instant application]”. Therefore, Applicants respectfully request reconsideration and withdrawal of this rejection.

- **Telephone discussion between Applicants’ attorney and Examiner Kosar**

A telephone discussion took place between Applicants’ undersigned attorney and Examiner Kosar on this date, January 26th, to discuss whether TARASOVA (WO 03/072754) was correctly applied as Section 102(b) art. Examiner Kosar mentioned that he was considering the possibility of whether the amendment to Claim 1, which was previously submitted on March 3, 2010, so as to define B¹⁻⁴ such that one of B¹⁻⁴ is -(C(O)-A1-A2-A3-A4-A5-C(O))_s-, is not entitled to the priority date of April 22, 2003 for the US Provisional Application No. 60/464,528.

Applicants’ attorney noted for the Examiner that the amendment in question is fully supported in the US Provisional Application No. 60/464,528, but that is beside the point because the International Publication Date of TARASOVA (WO 03/072754) is September 4, 2003 and the International Filing Date of the instant application is April 21, 2004, which would still render TARASOVA (WO 03/072754) ineligible as Section 102(b) art, even if it is assumed *in arguendo* that the amendment in question is not entitled to the priority date.

Nonetheless, Applicants’ attorney indicated to Examiner Kosar that Applicants will amend Claim 1 in order to remove any possible overlap with TARASOVA (WO 03/072754),

solely in order to avoid any potential complication and/or delay that might arise from the possibility that the Examiner might apply TARASOVA (WO 03/072754) under different subsection of Section 102, other than 102(b). Specifically, Claim 1 is amended herein so as to define B^{1-4} such that at least one of B^{1-4} is $(Doc)_m$ or $(Aepa)_n$ wherein at least one of m and n is not 0. This amendment is equivalent to incorporating the limitations of Claim 13 into Claim 1; accordingly, Claim 13 is canceled herein. Applicants have also amended Claim 14 to delete a number of compounds that do falls outside of the scope of Claim 1, as amended.

Applicants respectfully submit that the amendments proposed herein render Claims 1, 2 and 20 novel and not anticipated by TARASOVA (WO 03/072754). Applicants respectfully request reconsideration and withdrawal of Claims 1, 2 and 20 under 35 U.S.C. §102(b), or any other subsection of Section 102 not yet made of record.

CONCLUSION

Reconsideration of the instant Office Action, entry of the amendments submitted herewith, and allowance of all pending claims are respectfully requested. Prompt and favorable action is solicited. Examiner Kosar is invited to telephone the Applicants' undersigned attorney if deemed necessary to facilitate prosecution of the instant application

Respectfully submitted,

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/Tony K. Uhm/

Tony K. Uhm (Reg. No. 52,450)
Attorney for Applicants

Biomeasure, Incorporated
27 Maple Street
Milford, MA 01757-3650
telephone: (774) 396-6976
telecopier: (508) 478-2530